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09/634,916	08/09/2000	Frank Simon	032693-043	6828

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BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER
KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/634,916	Applicant(s) SIMON ET AL.	
	Examiner Stefano Karmis	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 1/2/03 .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) 1-20 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claims 1-20 are objected to because of the following informalities: Claims are required to be listed on a separate sheet of paper with no other information. Remove Applicant's names and Title. Appropriate correction is required.

Double Patenting

2. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

3. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in the public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

4. Claims 1 and 11-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,195,648 Simon et al. (hereinafter Simon). Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

In reference to claim 1, this claim recites a method of enabling and disabling equipment in response to payments being timely made while claim 1 of the '648 application recites a method of enabling and disabling a motor vehicle in response to payments being timely made (column 10, lines 9-11). The instant claim 1 does not include limitations regarding the detail of the equipment for enabling and disabling. Furthermore, instant claim 1 does not include the limitation of a motor vehicle loan when computing the payment due deadline and a motor vehicle ignition in the disabling of the system. The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claim 1, the deletion of a enabling and disabling a motor vehicle in connection with timely payments from the patented claim would have been an obvious expedient as above. It would have been obvious for one of ordinary skill in the art to omit such elements along with their functions from the method recited in claim 1. The omission would have been obvious because one of ordinary skill would be motivated to expedite the operation of the system of claim 1 of the '648 application.

In instant claim 1, the claim recites that codes are provided for a comparator and another code is received and then also sent to the comparator while claim 1 of the '648 application recites providing a code to the comparator via a computer interface and receiving an additional code via a keypad from a user (column 10, lines 17-19). The instant claim 1 does not include limitations regarding the origin of the codes. The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claim 1, the deletion of receiving a code via a keypad from a user from the patented claim would have been an obvious expedient as above. It would have been obvious for one of ordinary skill in the art to omit such elements along with their functions from the method recited in claim 1. The omission would have been obvious because one of ordinary skill would be motivated to provide the codes thus revealing their origin as in claim 1 of the '648 application.

Claim 11 of the instant application recites a method of enabling and disabling equipment in response to payments being timely made while claim 2 of the '648 application recites a method of enabling and disabling a motor vehicle in response to payments being timely made (column 10, lines 31-32). The instant claim 11 does not include limitations regarding the detail of the equipment for enabling and disabling. The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claim 11, the deletion of a motor vehicle as the apparatus for enabling and disabling from the patented claim would have been an obvious expedient as above. It would

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have been obvious for one of ordinary skill in the art to omit such elements along with their functions from the method recited in claim 2. The omission would have been obvious because one of ordinary skill would be motivated to expedite the operation of the method of claim 2 of the '648 application.

The instant claim 11, recites a critical system interruption circuit connected to a critical system of the equipment and in communication with a logic processing unit operable for performing logic operations while the '648 application recites a disabling module connected to a system that supports causing ignition in an engine of said motor vehicle and a control module in communication with said disabling module (column 10, lines 33-37). It would be obvious to one of ordinary skill in the art that the processes perform the same function.

Claim 12 of the instant application recites a logic processing unit that uses reference codes providing means, for a comparator operable for comparing reference codes with received codes and triggering events in responds to said comparisons and said reference code providing means being operable for periodically providing reference code to said comparator where said reverence codes correspond to payment which are to be made, while claim 2 of the '648 application uses reference codes providing modules, for a comparator operable for comparing reference codes with received codes and triggering events in responds to said comparisons and said reference code providing modules being operable for periodically providing reference code to said comparator where said reverence codes correspond to payment which are to be made

(column 10, lines 42-49). It would be obvious to anyone of ordinary skill in the art that means and module can be used interchangeably without altering the claim.

Instant claims 11 and 12 do not include the limitation of a disabling module that disables the system that supports causing ignition when said code is not in agreement with said reference code before a predetermined time exceeds a predetermined deadline, and wherein the system that supports causing ignition includes only component's not dedicated to directly ceasing a spark to initiate combustion (column 10, lines 50-56). The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claim 1, the deletion of a disabling module that disables the system that supports causing ignition when said code is not in agreement with said reference code before a predetermined time from the patented claim would have been an obvious expedient as above. It would have been obvious for one of ordinary skill in the art to omit such elements along with their functions from the apparatus recited in claim 2. The omission would have been obvious because one of ordinary skill would be motivated to provide a timeline for payment before the necessary step of disabling the motor vehicle through the ignition is performed.

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a)** A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler (US Patent No. 5,969,633).

8. Regarding claim 1, Rosler teaches a method for enabling and disabling equipment comprising the steps:

-generating a reference code; providing to a comparator for the reference code; receiving a code; comparing received code with reference code; disabling a critical system if agreement between received code and reference code is not detected; enabling ignition if agreement between entered code and reference code is detected (see col. 1 lines 4-14 and col. 3, lines 13-16). Rosler fails to disclose the enabling and disabling of the equipment is in response to payments being timely made. Applicant, on the other hand, has disclose in the specification under the Prior Art section that such enabling and disabling system can be used in response to payments being timely made (see specification page 1). Applicant did not recite a payment due deadline is being computed. Official Notice is taken that it is old and well known in business practice that payment is generated with deadline due date when a loan is being enforced. It

would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include payment deadline computation with Rosler and Applicant's Prior Art because it will enable loan company to reinforce the payment of the vehicle in a timely manner.

Regarding claim 2, Rosler in view of Applicant's Prior Art teaches a method as set forth in claim 1. Rosler and Applicant fail to disclose the limitation of the computing of deadline payment further defined as computing a payment deadline in agreement with terms of a loan formula having parameters in the group: total number of payments, payment period, grace period, and start date. However, Official Notice is taken that it is old and well known in the business practice that any loan payment is computed with payment deadline in agreement with terms of a loan formula having parameters such as number of payment, payment period, grace period and start date (i.e. car and student loan). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include payment deadline computation with Rosler and Applicant's Prior Art because it will enable loan company to reinforce the payment of the vehicle in a timely manner.

Regarding claim 3, Rosler in view of Applicant's Prior Art teaches a method as set forth in claim 2. Rosler and Applicant fail to disclose the computing due deadline step being performed in an initialization process where a host computing apparatus is connected to a client computing apparatus, the host computing apparatus providing the client computing apparatus with a database including a plurality of payment due deadline data elements. Official Notice is taken that it is old and well known in the computer art that a host computer connected to a client computer and host computer providing the client computer with a database of payment

information. (i.e. consumers accessing company's web site to check on their accounts or billing information via the Internet). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the accessibility of consumer's account with Rosler and Applicant's Prior Art because it will enable consumer keep up to day of their payment information even during company's non-operational hours.

Regarding claim 4, Rosler in view of Applicant's Prior Art teaches a method as set forth in claim 2. Rosler and Applicant fail to disclose the computing of payment due deadline is performed by a logic processor from time to time throughout the life of the loan. Official Notice is taken that it is old and well known in business art to compute monthly payment due deadline via a computer (logic processor) monthly throughout the life of the loan. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include payment deadline computation from time to time throughout the life of the loan with Rosler and Applicant's Prior Art because it will enable loan company to reinforce the payment of the vehicle in a timely manner.

Regarding to claim 5, Rosler in view of Applicant's Prior Art teaches a method as set forth in claim 1. Rosler and Applicant fail to disclose the reference code occurs in an initialization process where reference codes are computed together and provided to an apparatus as a data set. Official Notice is taken that is old and well known in the computer art to generate a set of code and store them in a memory or database. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the computation of reference code and store them in memory or database with Rosler and Applicant's Prior Art because it will ensure that a new code is needed in order to verify that a new code is needed to be

entered by the consumer before the next payment is due to enforce the loan being paid in a timely matter.

Regarding claim 6, Rosler in view of Applicant's Prior Art teaches a method as set forth in claim 1. Rosler further discloses generating a reference code occurs in a logic processor for specific time period (see col. 4, lines 11-13; col. 3, lines 66 and 67).

Regarding claim 7, Rosler in view of Applicant's Prior Art teaches a method as set forth in claim 1. Rosler further discloses the receiving entry of a code via a user interface includes a user manipulating an apparatus to convey a code to a logic process (see fig. 12 and col. 4, lines 11-13).

Regarding claim 8, Rosler in view of Applicant's Prior Art teaches a method as set forth in claim 1. Rosler further discloses the comparing entered code with reference code step includes determining if a correspondence between codes exists (see col. 4, lines 21-23). 11)

Regarding claim 9, Rosler in view of Applicant's Prior Art teaches a method as set forth in claim 1. Rosler further discloses the disabling a critical system is temporarily causing the critical systems of the equipment to be blocked or inoperable (see col. 3, lines 13-16). 12)

Regarding claim 10, Rosler in view of Applicant's Prior Art teaches a method as set forth in claim 1. Rosler further discloses the enabling the critical system is releasing a disabling critical system from its disabled state or leaving an operable critical system in an operable condition (see col. 4, lines 23-31).

Regarding claim 11, Rosler teaches an apparatus for enabling and disabling equipment comprising:

-a critical system interruption circuit connected to a critical system of the equipment and in communication with (see col. 3, lines 13-15);

- a logic processing unit operable for performing logic operations, the logic processing unit further being in communication with (see col. 4, lines 11-14);

- means for periodically receiving a code and transmitting the code to the logic processing unit (see fig. 1, items 12 and col. 4, lines 11-14). Rosler fails to disclose the enabling and disabling of the equipment is in response to payments being timely made. Applicant, on the other hand, has disclose in the specification under the Prior Art section that such enabling and disabling system can be used in response to payments being timely made (see specification page 1).

Regarding claim 12, Rosler in view of Applicant's Prior Art teaches an apparatus as set forth in claim 11. Rosler further discloses the logic processing unit comprising:

-a comparator (see col. 4, lines 20-21); and

-a reference code providing means (see fig. 1, item 10);

the comparator operable for comparing reference codes with received codes and triggering events in response to the comparisons (see col. 4, 21-25), and the reference code providing means being operable for periodically providing reference codes to the comparator where the reference codes correspond to the specific time period (see fig. 1, item 10 and col. 4, lines 23-25).

Regarding claim 13, Rosler in view of Applicant's Prior Art teaches an apparatus as set forth in claim 12. Rosler further discloses the means for periodically receiving a code is a user

interface whereby a user may manipulate the interface to cause a code to be received at the apparatus (see fig. 1, item 12 and col. l, lines 46-48; Applicant defines user interface as input device in specification. See specification page 8).

Regarding claim 14, Rosler in view of Applicant's Prior Art teaches an apparatus as set forth in claim 13. Rosler further disclose that the user interface is in electronic communication with the logic processing unit (see fig. 1, item 12 and col. 4, lines 11-13).

Regarding claim 15, Rosler in view of Applicant's Prior Art teaches an apparatus as set forth in claim 14, Rosler further discloses the user interface is a keypad, which converts tactile input to digital code (see col. 2, line 3).

Regarding claim 16, Rosler in view of Applicant's Prior Art teaches an apparatus as set forth in claim 12. Rosler further discloses means for periodically receiving a code is an automatic system, which operates without user input (see col. 2, lines 55-56 and col. 2, line 65-col. 3 line 2).

Regarding claim 17, Rosler in view of Applicant's Prior Art teaches an apparatus as set forth in claim 16. Rosler further discloses the automatic system is an arrangement of a modem and telephone communication link (see col. 1, lines 55-56).

Regarding claim 18, Rosler in view of Applicant's Prior Art teaches an apparatus as set forth in claim *16.* Rosler further discloses the automatic system is radio receiver (see col. l, line 55).

Regarding claim 19, Rosler in view of Applicant's Prior Art teaches an apparatus as set forth in claim 11. Rosler further discloses the equipment is an automobile (see col. 1, line *19).*

Regarding claim 20, Rosler in view of Applicant's Prior Art teaches an apparatus as set forth in claim *19* where critical system is an ignition system (see col. 3, line 14).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted
Stefano Karmis
January 2, 2003

HANI M. KAZIMI
PRIMARY EXAMINER